

Serial No. 10/058,494

REMARKS

Claims 1-10 are pending in the present application. Independent claim 7 has been amended. Reconsideration of the present application is respectfully requested in view of the amendments and arguments set forth herein.

In the Office Action, claims 7-10 were rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Ishii (U.S. Patent No. 6,594,505). Claims 1-7 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Ishii (U.S. Patent No. 6,594,505) in view of Mohammed (U.S. Patent No. 6,647,426). Applicants respectfully traverse the Examiner's rejection.

Independent claims 1, 5, and 7 set forth, among other things, physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols. For example, an expansion card may be physically inserted into an expansion slot of a personal data assistant. See Patent Application, page 6, ll. 20-25. In contrast, Ishii describes a mobile radio telephone 3 that may download communication protocol software from a base station 1 over a wireless communication link or air interface. See Ishii, col. 5, ll. 1-6 and Figure 1. However, the mobile radio telephone 3 is not physically attached to the base station 1. Thus, as admitted by the Examiner, Ishii fails to teach or suggest physically attaching a first electronic device having a first communication protocol to a second device having a plurality of communication protocols, as set forth in independent claims 1, 5, and 7.

For at least the aforementioned reasons, Applicants respectfully submit that the present invention is not anticipated by Ishii and request that the Examiner's rejections of claims 7-10 under 35 U.S.C. § 102(e) be withdrawn.

Serial No. 10/058,494

Moreover, it is respectfully submitted that the pending claims are not obvious in view of Ishii and Mohammed, either alone or in combination. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). As discussed above and as admitted by the Examiner, Ishii fails to teach or suggest a first electronic device having a first communication protocol that is physically attached to a second device having a plurality of communication protocols. Mohammed describes connecting a desktop phone to a base station 18 so that a user may communicate using either the desktop phone or a subscriber device 12 that communicates with the base station 18 over an air interface. For example, the desktop phone may be connected to the base station 18 using a landline. See Mohammed, col. 16, ll. 61 – col. 17, ll. 14.

The Examiner that alleges that it would be obvious to one of ordinary skill in the art to modify Ishii so that the mobile radio telephone 3 may be physically connected to the base station 1, *e.g.*, by the landline described in Mohammed. Applicants respectfully disagree and submit that the prior art of record contains no suggestion or motivation for the Examiner's proposed modification and combination of the cited references. To the contrary, both of the cited references teach away from the Examiner's proposed modification and combination of the references.

Ishii teaches that mobile telephones located in a communication area associated with either a first or second base station may download first or second mobile radio telephone communication protocol software from the first or second base stations depending on which base station is serving the communication area. See Ishii, col. 4, ll. 27-51. When taken in context, Applicants submit that the description in Ishii is describing downloading the mobile radio

Serial No. 10/058,494

telephone communication protocol software over an air interface. Consequently, Applicants respectfully submit that Ishii teaches away from physically connecting a mobile telephone to a base station.

As discussed above, Mohammed describes connecting a desktop phone to a base station 18 so that a user may communicate using either the desktop phone or a subscriber device 12 that communicates with the base station 18 over an air interface. See Mohammed, col. 16, ll. 61 – col. 17, ll. 14. Thus, Mohammed teaches that the subscriber device 12 may be used when it is desirable to communicate over the air interface and the desktop phone may be used when it is desirable to communicate over the landline. Applicants therefore submit that Mohammed teaches away from physically connecting a mobile telephone or subscriber device 12 to a base station.

It is by now well established that teaching away by the prior art constitutes *prima facie* evidence that the claimed invention is not obvious. See, *inter alia*, *In re Fine*, 5 U.S.P.Q.2d (BNA) 1596, 1599 (Fed. Cir. 1988); *In re Nielson*, 2 U.S.P.Q.2d (BNA) 1525, 1528 (Fed. Cir. 1987); *In re Hedges*, 228 U.S.P.Q. (BNA) 685, 687 (Fed. Cir. 1986).

For at least the aforementioned reasons, Applicants respectfully submit that the Examiner has failed to make a *prima facie* case that the present invention is obvious over the prior art of record. Applicants request that the Examiner's rejections of claims 1-7 under 35 U.S.C. § 103(a) be withdrawn.

For at least the aforementioned reasons, it is respectfully submitted that all pending claims are in condition for immediate allowance. The Examiner is invited to contact the undersigned agent at (713) 934-4052 with any questions, comments or suggestions relating to the referenced patent application.


Respectfully submitted,

Serial No. 10/058,494

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